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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/790,531 | 03/01/2004 | Daniel L. Carter | 2002-0852.01/4670-270 | 2754 |
| 7590 03/21/2008 LEXMARK INTERNATIONAL, INC. ATT: JOHN J. McARDLE, JR. 740 WEST NEW CIRCLE ROAD LEXINGTON, KY 40550 | | | EXAMINER MORRISON, THOMAS A | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,531

Applicant(s)

CARTER ET AL.

Examiner

THOMAS A. MORRISON

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12-18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-18, 20 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The indicated allowability of claims 21-29 is withdrawn in view of the newly discovered reference(s) to Japanese Publication No. 2000-26002. Rejections based on the newly cited reference(s) follow. The examiner regrets not finding this reference at an earlier time, and regrets any inconvenience that may have been caused by this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, this claim does not positively recite the structure that controls movement of the diverter to the second position. As such, it is unclear what controls the movement of the diverter. For example, claim 1 now recites "the diverter **controlled** to move to a second position when the drive roll rotates in a second direction to align a second guide edge of the diverter to guide the first media sheet out of the first media nip". (emphasis added).

Regarding claim 6, this claim now depends from claim 5, which was canceled. As such, it is unclear what limitations are included in claim 6.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10, 12 and 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 2000-26002.

Regarding claim 10, Figs. 1-12 show a device to move media sheets (9-1 and 9-2) simultaneously within an image forming apparatus (Fig. 1) comprising:

a drive roll (13-1) positioned against a first roll (13-2) to form a first nip and positioned against a second roll (13-3) to form a second nip;

a diverter (14) positioned completely upstream from the drive roll (13-1) and operatively connected to the drive roll (13-1) and having a first guide edge (edge inside element 14) and a second guide edge (top surface of element 14), the diverter (14) adapted to be positioned between a first orientation (up) and a second orientation (down);

the diverter (14) positioned in the first orientation (up) when the drive roll (13-1) rotates in a first rotational direction (counter-clockwise) to guide along the first guide edge (edge inside element 14) a first media sheet (9-1) that is driven by the first nip in a first direction (left);

the diverter (14) positioned in the second orientation (down) when the drive roll (13-1) rotates in a second rotational direction (clockwise) to guide along the second

guide edge (top surface of element 14) the first media sheet (9-1) that is driven by the first nip in a second direction (right), and simultaneously guide a second media sheet (9-2) along the first guide edge (edge inside element 14) that is being driven by the second nip in the first direction (left).

Regarding claim 12, Figs. 1-12 and the English Abstract disclose that the first roll (13-2) and the second roll (13-3) are positioned in contact with the drive roll (13-1) and rotation of the drive roll (13-1) rotates both the first roll (13-2) and the second roll (13-3).

Regarding claim 21, Figs. 1-12 and the English Abstract disclose a method of simultaneously moving two media sheets with a drive roll (13-1) in an image forming device (Fig. 1), the method comprising the steps of:

- rotating a drive roll (13-1) in a first rotational direction (counter-clockwise);
- positioning a diverter (14) in a first orientation (up) and directing a first media sheet (9-1) moving along a first media path into a first nip formed between the drive roll (13-1) and a first roll (13-2);

- reversing the drive roll (13-1) to a second rotational direction (clockwise) while the first media sheet (9-1) is within the first nip;

- positioning the diverter (14) in a second orientation (down) and directing the first sheet (9-1) out of the first nip and simultaneously directing a second media sheet (9-2) into a second nip formed between the drive roll (13-1) and a second roll (13-3); and

- rotating the drive roll (13-1) and simultaneously moving the first sheet (9-1) in a second direction out of the first nip and moving the second sheet (9-2) in a first direction out of the second nip.

Regarding claim 22, Figs. 1-12 and the English Abstract disclose reversing the direction of the drive roll (13-1) to the second rotational direction (clockwise) causes the diverter to move to the second orientation (down).

Regarding claim 23, Figs. 1-12 and the English Abstract disclose that the step of reversing the direction of the drive roll (13-1) to the second rotational direction (clockwise) occurs after a trailing edge of the first sheet (9-1) passes beyond the diverter (14).

Regarding claim 24, Figs. 1-12 and the English Abstract disclose partially extending the first media sheet (9-1) out of the image forming device (Fig. 1) before reversing the drive roll (13-1) to the second rotational direction (clockwise).

Regarding claim 25, Figs. 1-12 and the English Abstract disclose rotating the drive roll (13-1) and moving the first sheet (9-1) in the second direction out of the first nip and into a duplexing path (Fig. 2).

Regarding claim 26, Figs. 1-12 and the English Abstract disclose moving the second sheet (9-2) in the first direction out of the second nip and discharging the second sheet (9-2) from the image forming device (Fig. 1).

Regarding claim 27, Figs. 1-12 and the English Abstract disclose a method of simultaneously moving two media sheets (9-1 and 9-2) with a drive roll (13-1) in an image forming device (Fig. 1), the method comprising the steps of:

- rotating a drive roll (13-1) in a first rotational direction (counter-clockwise);
- directing a first media sheet (9-1) along a first guide edge (inside edge) of a diverter (14) into a first nip formed between the drive roll (13-1) and a first roll (13-2);

moving the first sheet (9-1) through the first nip in a first direction (left) and partially out of the image forming device (Fig. 1);

reversing the drive roll (13-1) to a second rotational direction (clockwise) and pulling the first sheet (9-1) moving in a second direction (right) in the first nip into the image forming device (Fig. 1);

positioning the diverter (14) in a second orientation (down) and directing the first sheet (9-1) moving in the second direction (right) out of the first nip and into a duplexing path (Fig. 2) while simultaneously directing a second media sheet (9-2) into a second nip formed between the drive roll (13-1) and a second roll (13-3).

Regarding claim 28, Figs. 1-12 and the English Abstract disclose rotating the drive roll (13-1) and moving the first sheet (9-1) in the second direction (right) out of the first nip and moving the second sheet (9-2) in the first direction (left) out of the second nip and out of the image forming device (Fig. 1).

Regarding claim 29, Figs. 1-12 and the English Abstract disclose a method of simultaneously moving two media sheets (9-1 and 9-2) with a drive roll (13-1) in an image forming device (Fig. 1), the method comprising the steps of:

directing a first media sheet (9-1) moving along a first media path and contacting a leading edge against the drive roll (13-1);

rotating the drive roll (13-1) in a first rotational direction (counter-clockwise) and moving the leading edge along the drive roll (13-1) and into a first nip formed between the drive roll (13-1) and a first roll (13-2);

reversing the drive roll (13-1) to a second rotational direction (clockwise) while the first media sheet (9-1) is within the first nip;

while the first media sheet (9-1) is within the first nip, directing a second media sheet (9-2) moving along the first media path and contacting the second media sheet (9-2) leading edge against the drive roll (13-1) and into a second nip formed between the drive roll (13-1) and a second roll (13-3); and

rotating the drive roll (13-1) and simultaneously moving the first media sheet (9-1) in a first direction (right) out of the first nip and moving the second media sheet (9-2) in a second direction (left) out of the second nip.

Allowable Subject Matter

4. Claims 13-18 and 20 are allowed. Claims 1-4 and 7-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The allowability of claim 6 cannot be determined in view of the fact that this claim currently depends from a canceled claim.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

3/16/2008